



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,441	10/29/2003	Perry N. Law	P67936US0	4583

136 7590 09/19/2006

JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

EXAMINER

NASSER, ROBERT L

ART UNIT	PAPER NUMBER
----------	--------------

3735

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

82

Office Action Summary	Application No.	Applicant(s)	
	10/695,441	LAW ET AL.	
	Examiner	Art Unit	
	Robert L. Nasser	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 4, 6, 12, 13 and 16 is/are allowed.
- 6) ☒ Claim(s) 5, 7-11, 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3735

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 recites that the bladder conforms to the finger, which recites a positive relationship to the human body. The human body is non-statutory and cannot be positively recited. As such, the claim recites non-statutory subject matter. Applicant should amend the claim to recite that the bladder is adapted to conform, or use similar language.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7-11, and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 19 recites that the number of emitters and detectors can be selected based on other parameters to be measured. It is unclear what other parameters are measured in this claim and therefore unclear what the scope of the claim is.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7-11, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geddes et al 6801798 in view of Itonaga et al 5807266. Geddes shows a device having a rigid tube 12 and an elastic sleeve connected at the ends thereof to create a cuff, a plurality of emitters and detectors that sense a signal indicative of volume or change in volume (see figure 5) (22, 24 noting that one emitter and one detector are 2 emitters and detectors, which are a plurality). The bladder 14 has an inner surface and an outer surface, where when it is inflated, an internal volume is produced between the inner surface and the tube 12 and where the bladder is filled in a normal state and evacuated in a relaxed state. The examiner also notes that the reference has a plurality of emitters and detectors and that the reasons for selecting the number is irrelevant as long as the structure is the same. The emitters and detectors are not within the internal volume and the bladder is not pigmented as discussed in the final paragraph. Itonaga rectifies both deficiencies. First, Itonaga shows an optical blood pressure measuring device where the sensors are located in the inflated volume. Hence, it would have been obvious to modify Geddes to locate the sensors inside the volume, as it is merely the substitution of one known equivalent configuration for another. Secondly, Itonaga teaches making a bladder in an optical blood pressure measuring device black (see column 6, line 41) to minimize interference and light piping. Hence, it would have been obvious to modify Geddes to color the bladder black to eliminate interference. Claim 5 is rejected in that there is a tube 16 that meets the limitations of the claim. With respect to claims 7, the bladder is capable of conforming to the finger without any wrinkles or gaps when inflated and conforming to the tube

Art Unit: 3735

when deflated. As to claim 8, the limitations as to the intended size of the finger to be used is an intended use limitation. The device of the combination is capable of being used in the manner recited. In other words, the "intended" finger size is unknown and therefore, the cuff meets the claim limitation, depending on the size of the finger. With respect to claims 9 and 11, Geddes teaches that the bladder is elastic. With respect to claims 9 and 11, judging by the nature of use of Geddes, it is the examiner's position that it would necessarily have to meet the limitations claims 9 (expansion size) and 11 (thickness) in order to perform as described. Alternatively, the exact thickness of the device would have been an obvious matter of design choice for one skilled in the art. As to claim 10, the Itonaga teaches that rubber is a known bladder material. Hence, it would have been obvious to select rubber as the elastic material in Geddes, as it is a well known material for the purpose.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geddes et al in view of Itonaga, as applied to claims 5, 7-11, and 19 above, and further in view of Ukawa 5676140. Ukawa et al further teaches the use of a plurality of light sources (5a, 5b, 5c) aligned linearly along the longitudinal axis of the cuff. As such, it would have been obvious to modify the above combination to use such an arrangement of sources, as it is merely the substitution of one known source for another.

Claims 3, 4, 6, 12, 13, and 16 are allowable.

Claims 3 and 4 define over the art in that none of the art shows the ends having a greater thickness than the middle, as claimed. Since applicant has described this as

Art Unit: 3735

part of a scheme to have the cuff evacuate uniformly and prevent bunching of the cuff during measurements, it is the examiner's position that the feature is more than mere design choice.

Claims 6, 12, and 13 define over the art in that none of the art teaches the two stiffening ribs on the inner surface of the bladder, as claimed.

Claim 16 define over the art in that none of the art as the rib with the light source and detector therein, as claimed.

Applicant's arguments filed 7/27/2006 have been fully considered but they are not persuasive.

Applicant has argued that there is no case law supporting the rejection of claim 7 under 35 U.S.C. 101 for claiming the human body. MPEP 2105 and OG Notice 1077 OG 24 (April 21, 1987) both establish that the human body cannot be claimed positively.

Applicant has also asserted that claim 19 is definite. The examiner disagrees. The claims recites that the number of emitters used (or wavelengths) is governed by the number of parameters being measured. There is no control means to vary the number of emitters. Therefore, it is unclear how many emitters are in the device, as applicant has not recited how many parameters are being measured. Essentially, applicant has not provided a definite recitation of what elements are in the claim.

The affidavit filed by David Bell has been considered, but has not been found to be persuasive. Mr. Bell argues that making Geddes' cuff black would inhibit light transmission therethrough and prevent measurements from being made. The examiner notes that Itonaga provides slits to allow the light to pass through and measurements to

Art Unit: 3735

be made and makes the cuff black, to block extraneous light. Accordingly, it is the examiner's position that the combination does not destroy the intended operating function of Geddes.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is 571 272-4731. The examiner can normally be reached on m-f 9-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on 571 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3735

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert L. Nasser
Primary Examiner
Art Unit 3735

RLN
August 14, 2006


ROBERT L. NASSER
PRIMARY EXAMINER